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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/872,655 | 06/01/2001 | Greg M. Atkin | 6090-A | 2790 |

7590

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Richard L. Myers
MYERS, DAWES & ANDRAS LLP
Suite 1150
19900 MacArthur Blvd.
Irvine, CA 92612

EXAMINER

LOCKETT, KIMBERLY R

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2837

DATE MAILED: 12/17/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,655

Applicant(s)

ATKIN, GREG M.

Examiner

Kim R. Lockett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-18 and 23-25 is/are allowed.
- 6) ☒ Claim(s) 1-9, 19-22, and 26-37 is/are rejected.
- 7) ☐ Claim(s) 38,39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Newman.

Newman teaches a pick apparatus adapted for use by a user having a thumb with a means, to strum/pick strings of a musical instrument, comprising: a pick (30) adapted to be held by the use and to be moved in a connecting and strumming relationship with the strings of the musical instrument; a thumb sleeve(40) adapted for disposition on the thumb of a user; attachment means including a first structure carried by the sleeve and a second structure carried by the pick (see figure 16), the attachment means being adapted for releasably attaching the pick to the sleeve; the attached pick being moveable by the fingers of the use between a first position and a second position spaced from the first position on the meatus of the thumb (see figure 13) (claims 1 and 18).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-7, 19-22 and 26-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Mapson.

Newman does not teach specifically that his pick has a tip and a longitudinal configuration where the first is laterally and longitudinally spaced from the second position on the meatus of the thumb

Regarding claims 2, 31, 32, and 3, Mapson also discloses a device where the thumb is disposed generally in a plane and has a tip and a longitudinal configuration where the first is laterally and longitudinally spaced from the second position on the meatus of the thumb (see figure 2).

Regarding claims 4-7, 33-35. Newman also teaches the pick in different positions with first angles and second angles in proximal relationship to the tip of the thumb (see figures 2 and 5-8).

Regarding claims 19 and 27, Newman discloses a device where the attachment means(180) and the pick are disposed exteriorly of the sleeve.

Regarding claims 20, 28, 29, and 21, Newman discloses a device where the attachment means (80) and the pick are disposed interior of the sleeve with the tip projecting exteriorly and through the distal opening of the sleeve.

Regarding claim 22 and 30, the device as taught by Mapson included lateral holes(18) that extend through the sleeve.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the pick as taught by Newman so that the thumb is disposed generally in a plane and has a tip and a longitudinal configuration where the first is laterally and longitudinally spaced from the second position on the meatus of the thumb as taught by Mapson in order to provide a pick that is easily rotatable.

5. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Gallagher.

Newman does not disclose the use of a pad.

Gallagher discloses the use of a guitar pick with a pad(24) disposed on the side of the pick opposite the attachment means(26), the tapered pad having a first surface generally parallel to the plane of the pick and a second surface generally non-parallel to the plane of the pick (see figure 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the pick as taught by Newman with the pad as taught by Gallagher in order to provide a pick that conforms to the contours of the player's fingertip.

Allowable Subject Matter

6. Claims 10-18 and 23-25 are allowed.

7. Claims 38 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 9/23/02 have been fully considered but they are not persuasive. Newman clearly discloses Newman teaches a pick apparatus adapted for use by a user having a thumb with a means, to strum/pick strings of a musical instrument, comprising: a pick (30) adapted to be held by the use and to be moved in a connecting and strumming relationship with the strings of the musical instrument; a thumb sleeve(40) adapted for disposition on the thumb of a user; attachment means including a first structure carried by the sleeve and a second structure carried by the pick (see figure 16), the attachment means being adapted for releasably attaching the pick to the sleeve; the attached pick being moveable by the fingers of the use between a first position and a second position translationally spaced from the first position on the meatus of the thumb (see figure 13) .

The movement of the pick as taught by Newman clearly depends on the motion of the finger and since the meatus of the finger is holding the pick, the movement of the pick clearly depends on the movement of the finger. Therefore the positions of the pick can vary.

With regards to the applicant's arguments regarding no motivation to combine, "it has been held that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject

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matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. *In re Bozek*, 163 UPQ 545 (CCPA 1969)

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry of a general nature or relating to the status of this application or filed papers should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Papers related to this application may be submitted to Group 2800 by facsimile transmission. Papers should be faxed to Group 2800 via the PTO 2800 Fax Center located at Crystal Plaza 4. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 15, 1989). The Group 2800

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CP 4 Fax Center number is (703) 308-77(22 or 24). Fax numbers that provide an auto-reply fax receipt are: for before finals (703) 872-9318 and after finals (703) 872-9319.

For assistance in **Patent procedure, fees or general Patent questions** calls should be directed to the **Patents Assistance Center (PAC)** whose telephone number is **800-786-9199**. Assistance is also available on the Internet at www.uspto.gov.

For requesting **copies of Cited Art, Office Actions or the like, or General Problem solving**, calls should be directed to the **TC 2800 Customer Service Office** whose telephone number is **703-306-3329** or by fax at **703-306-5515**.

Any inquiry concerning **this communication or earlier communications from the examiner** should be directed to **Kim Lockett** whose telephone number is **(703) 308-7615**. The examiner can normally be reached on Monday through Thursday from 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Nappi, can be reached on (703) 308-3370.


Kim Lockett
Patent Examiner
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